

REMARKS:

Claims 1-34 are currently pending in the application.

Claims 1-34 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,038,668 to Chipman *et al.* ("*Chipman*") in view of U.S. Patent No. 6,094,680 to Hokanson ("*Hokanson*") and in further view of U.S. Patent No. 6,081,840 to Zhao ("*Zhao*").

A Final Office Action in the subject Application was mailed to the undersigned on 17 November 2006, which provided for a response period ending 17 February 2007. The Applicant filed an Amendment After Final on 8 January 2007, within two (2) months of the date of the Final Office Action. An Advisory Action was mailed to the undersigned on 23 February 2007. The Applicant respectfully reiterates here the arguments set forth in the Amendment After Final filed on 8 January\ 2007, as if fully set forth herein.

Although the Applicant believes claims 1-34 are directed to patentable subject matter without amendment, the Applicant has amended independent claims 1, 17, 33, and 34 to more particularly point out and distinctly claim the Applicant's invention. By making these amendments, the Applicant makes no admission concerning the merits of the Examiner's rejection, and respectfully reserve the right to address any statement or averment of the Examiner not specifically addressed in this response. Particularly, the Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

The Applicant initially notes that the Office Action fails to properly establish a *prima facie* case of obviousness over dependent Claim 7. Although, the Examiner acknowledges that "Claims 1-34 are pending in the application", the Examiner has not asserted any argument or remarks to support the rejection of dependent Claim 7 under 35 U.S.C. § 103(a). (17 November 2006 Office Action, Page 1). Therefore, if the Examiner continues to maintain the rejection of dependent Claim 7 under 35 U.S.C. § 103(a), the Applicant respectfully requests that the Examiner provide a proper argument in support of the Examiner's rejection, as necessitated by MPEP § 706.02(j). For at least the reasons

set forth herein, the Applicant respectfully requests that the rejection of dependent Claim 7 under 35 U.S.C. § 103(a) be reconsidered and that dependent Claim 7 be allowed.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-34 stand rejected under 35 U.S.C. § 103(a) over *Chipman* in view of *Hokanson* and in further view of *Zhao*.

The Applicant respectfully submits that the ***amendments to independent Claims 1, 17, 33, and 34 have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims.*** The Applicant further respectfully submits that amended independent Claims 1, 17, 33, and 34 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Chipman*, *Hokanson*, or *Zhao*, either individually or in combination. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of Claims 1-34 under 35 U.S.C. § 103(a) over the proposed combination of *Chipman*, *Hokanson*, and *Zhao*, either individually or in combination.

The Proposed *Chipman-Hokanson-Zhao* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims

For example, with respect to independent Claim 1, this claim recites:

A method for ***migrating product data within an electronic commerce system***, comprising:

monitoring requests for product data by users of a global content directory, the global content directory comprising:

a directory structure comprising a plurality of product classes organized in a hierarchy, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class; and

one or more pointers associated with each product class, each pointer identifying a seller database in which product data enabling a product transaction is stored for products associated with the product class;

generating a request history for each of the users based on a prediction from the request history, that the user may request the

product data again, the request history comprises the number of requests by each of the users that result in the user accessing a particular seller database;

identifying the location of a particular user;

determining, based at least in part on the request history for the particular user and a relative size of an organization associated with the particular user, whether the product data requested by the particular user should be migrated from a seller database to a storage location that is closer to the identified location of the particular user than the seller database; and

if it is determined that the product data should be migrated, initiating the migration of the product data requested by the particular user from the seller database to the storage location, determined for the particular user, that is closer to the identified location of the particular user than the seller database. (Emphasis Added).

Independent Claims 17, 33, and 34 recite similar limitations. *Chipman, Hokanson, or Zhao* fails to disclose each and every limitation of independent Claims 1, 17, 33, and 34.

The Applicant respectfully submits that *Chipman, Hokanson, or Zhao*, either individually or in combination, fails to disclose, teach or suggest independent Claim 1 limitations regarding a method or software ***“for migrating product data within an electronic commerce system”*** and in particular *Chipman, Hokanson, or Zhao*, either individually or in combination, fails to disclose, teach or suggest independent Claim 1 limitations regarding ***“generating a request history for each of the users based on a prediction from the request history, that the user may request the product data again, the request history comprises the number of requests by each of the users that result in the user accessing a particular seller database”***. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Chipman, Hokanson, Zhao*, and independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Chipman, Hokanson, and Zhao*.

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Chipman-Hokanson-Zhao* Combination

The Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Chipman*, *Hokanson*, or *Zhao*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that "it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of *Chipman* and include the ability to migrate product data from sellers databases to storage locations closer to the user that requested the information as taught by *Hokanson*" and "include generating request histories for each user based on the teachings of *Hokanson* and *Zhao*". (17 November 2006 Office Action, Pages 9-10). (Emphasis Added). The Applicant respectfully disagrees.

The Applicant further respectfully submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Chipman*, *Hokanson*, or *Zhao*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be because "moving or locating high level descriptive information to a location more local to the user would facilitate quick access to the variety of information stored locally". (17 November 2006 Office Action, Page 9). The Applicant respectfully disagrees and further respectfully requests clarification as to how the Examiner arrives at this conclusion. The Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common

sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the ***Examiner has not adequately supported the selection and combination of Chipman, Hokanson, or Zhao to render obvious the Applicants claimed invention.*** The Examiner's unsupported conclusory statements that "it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of *Chipman* and include the ability to migrate product data from sellers databases to storage locations closer to the user that requested the information as taught by *Hokanson*" and "include generating request histories for each user based on the teachings of *Hokanson* and *Zhao*" and because "moving or locating high level descriptive information to a location more local to the user would facilitate quick access to the variety of information stored locally", ***does not adequately address the issue of motivation to combine.*** (17 November 2006 Office Action, Pages 9-10). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Chipman, Hokanson, or Zhao***, either individually or in combination.

The Examiner's Official-Notice is improper under MPEP § 2144.03

The Applicant respectfully submits that the Applicant is confused as to what the Examiner teaches by the Official Notice or even to the extent in which the Examiner is taking Official Notice. The Applicant respectfully requests clarification as to the subject matter for which Official Notice is being taken. ***The Applicant respectfully traverses the Official Notice because the asserted facts***, as best understood by the Applicant, ***are not supported by substantial documentary evidence or any type of documentary evidence*** and appear to be the Examiner's opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner's conclusion. (See MPEP §

2144.03). *The Applicant respectfully requests the Examiner to produce authority for the Examiner's Official Notice.*

Only "in limited circumstances," is it "appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection". (MPEP § 2144.03). "Official notice unsupported by documentary evidence **should only be taken by the examiner** where the facts asserted to be well-known, or to be common knowledge in the art are **capable of instant and unquestionable demonstration as being well-known**."

With respect to the subject Application, the Examiner's statement that the "Examiner takes Official Notice that it is well known in the art to delete or overwrite data that is determined to be no longer useful" and that "it is well known that a firewall provides a means for storing information within a computer in a secure manner that limits outsiders from accessing the data", **is not capable of instant and unquestionable demonstration as being well-known**. (17 November 2006 Office Action, Pages 11-12). As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be '**capable of such instant and unquestionable demonstration as to defy the dispute**' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

"It is **never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record**, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002)." (MPEP § 2144.03(A)).

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that **general**

conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

With respect to the subject Application, ***the Examiner has not properly Officially Noticed or not properly based the Official Notice on common knowledge.*** The Examiner's conclusory statement:

Examiner takes Official Notice that it is well known in the art to delete or overwrite data ***that is determined to be no longer useful.*** (17 November 2006 Office Action, Page 11). (Emphasis Added).

It is well known that ***a firewall provides a means for storing information within a computer*** in a secure manner that limits outsiders from accessing the data. (17 November 2006 Office Action, Page 12). (Emphasis Added).

The above noticed Examiner's conclusory statement ***does not adequately address the issue that this statement is considered to be common knowledge or well-known in the art.*** The Applicant respectfully submits the following statement, to further explain why the Examiner's above noticed statement is not considered to be common knowledge or well-known in the art.

First, it is not clear what the Examiner means by that it ***“is determined to be no longer useful”*** (i.e. what is ***“no longer useful”***, how is it ***“determined to be no longer useful”***, and to what extent does the Examiner purport that this ***determination of usefulness*** applies to the subject Application). In fact, the limitations recited in Claim 6 are directed to ***“determining that the product data should no longer be stored at the***

storage location determined for the particular user". It is not clear how the Examiner's purported **"no longer useful"** relates to the **"no longer [to] be stored"** or how it relates to "stored at the storage location" or even how it relates to being "determined for the particular user", as recited in Claim 6. The ***Applicant respectfully requests clarification as to how the Examiner arrives at this conclusion.***

Second, it is respectfully pointed out that the limitations recited in Claim 7 (of which, as pointed out above, the Examiner has not objected to or rejected), are directed to "determining that the particular user ***has not requested the product data*** for a ***specified period of time***". It is not clear how the Examiner's purported **"no longer useful"** relates to **"has not requested the product data"** or how it relates to "for a ***specified period of time***", as recited in Claim 7. The ***Applicant respectfully requests clarification as to how the Examiner arrives at this conclusion.***

Third, it is respectfully pointed out that the limitations recited in Claim 8 are directed to "determining that the ***storage location*** determined for the particular user ***is needed for migration and storage of product data for a second user***". It is not clear how the Examiner's purported **"no longer useful"** relates to **"is needed for migration and storage of product data for a second user"**, as recited in Claim 8. The ***Applicant respectfully requests clarification as to how the Examiner arrives at this conclusion.***

Fourth, it is not clear what the Examiner means by **"a firewall provides a means for storing information within a computer"** (i.e. how does **"a firewall"** provide **"a means for storing information within a computer"** or what **"means for storing information"** is the Examiner referring to and how is the **"storing information within a computer"** by **"a firewall"** related to the subject application). In fact, the limitations recited in Claim 14 are directed to **"product data [that] is migrated to a computer associated with the particular user of the global content directory"** wherein the **"product data is stored inside a firewall of the computer"**. It is not clear how the Examiner's purported **"means for storing information within a computer"** relates to the **"product data [that] is migrated to a computer associated with the particular user of the global content directory"** or how it relates to **"product data is stored inside a firewall of the computer"**, as recited in Claim

8. The ***Applicant respectfully requests clarification as to how the Examiner arrives at this conclusion.***

The Applicant respectfully submits that the Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of “***instant and unquestionable***” demonstration as being well-known. ***The Applicant respectfully requests the Examiner to produce authority for the Examiner’s statement*** “to delete or overwrite data that is determined to be no longer useful” and “a firewall provides a means for storing information within a computer in a secure manner that limits outsiders from accessing the data”, is old and well known.

The Applicant further respectfully submits that ***the Applicant has adequately traversed the Examiner’s assertion of Official Notice*** and directs the Examiner’s attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of Claims 6, 8, 14, 22-24, and 30 based on the Examiner’s Official Notice, ***the Applicant respectfully requests that the Examiner provide documentary evidence*** as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, ***the Applicant further respectfully requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding***, as further necessitated by MPEP § 2144.03(C).

The Applicant's Claims are Patentable over the Proposed *Chipman-Hokanson-Zhao* Combination

The Applicant respectfully submits that independent Claim 1 is considered patentably distinguishable over the proposed combination of *Chipman*, *Hokanson*, and *Zhao*. This being the case, independent Claims 17, 33, and 34 are also considered patentably distinguishable over the proposed combination of *Chipman*, *Hokanson*, and *Zhao*.

With respect to dependent Claims 2-16 and 18-32: Claims 2-16 depend from independent Claim 1 and Claims 18-32 depend from independent Claim 17. As mentioned above, each of independent Claims 1, 17, 33, and 34 are considered patentably distinguishable over *Chipman*, *Hokanson*, and *Zhao*. Thus, dependent Claims 2-16 and 18-32 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant respectfully submits that Claims 1-34 are not rendered obvious by the proposed combination of *Chipman*, *Hokanson*, and *Zhao*. The Applicant further respectfully submits that Claims 1-34 are in condition for allowance. Thus, the Applicant respectfully request that the rejection of Claims 1-34 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-34 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on Applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim

limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

A Request for Continued Examination (RCE) is being filed electronically herewith to facilitate the processing of this deposit account authorization. **The Commissioner is hereby authorized to charge the \$120.00 One-Month Extension of time fee, as well as the \$790.00 RCE fee, to Deposit Account No. 500777.**

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

21 March 2007
Date

/Steven J. Laureanti/signed
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